UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,624	09/18/2006	Michael Van Dievoet	P70901US0	9143

136   7590   09/16/2008
JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER
DONADO, FRANK E

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
09/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09/18/06</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 October 2005</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☒ All   b)☐ Some *   c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/06/06 and 12/20/06</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because figures 1-4 lack of descriptive labels. For example, in figure 1a, block 6 should be labeled as --CHARGER--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1.   Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

2.   Claims 1-10 are objected to because of the following informalities: **Initialisation**

should be changed to **initialization**. Appropriate correction is required.

3.   Claims 3 and 6 are objected to because of the following informalities:

Neutralisation and **neutralise** should be changed to **neutralization** and **neutralize**,

respectively. In claim 6 only, **initialise** should be changed to **initialize.** Appropriate

correction is required.

4.   Claims 1-5 and 7-9 are objected to because of the following informalities:

Characterised should be changed to **characterized**. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

6.   Claim 1 recites the limitations **"the operator"** and **"the data"**. There is

insufficient antecedent basis for this limitation in the claim.

7.   Claim 2 recites the limitation **"the data"**. There is insufficient antecedent basis

for this limitation in the claim

        Claims 3-10 are also rejected by virtue of their dependency on claims 1 and 2.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

        1.   Determining the scope and contents of the prior art.
        2.   Ascertaining the differences between the prior art and the claims at issue.
        3.   Resolving the level of ordinary skill in the pertinent art.
        4.   Considering objective evidence present in the application indicating
                obviousness or nonobviousness.

10.   Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Amin, et al **(US Patent 7,266,371),** in view of Mashiko **(US PG Publication**

2001/0029190). From now on, Amin, et al, will be referred to as Amin.

        Regarding claim 1, Amin teaches an assembly comprising a mobile telephone

supplied by a self-contained power source, an auxiliary memory and a charger arranged

so as to charge the power source, the said telephone being provided with a memory

arranged to store therein the data of the operator and data introduced by an owner of

the telephone, the said memory and auxiliary memory in each case being equipped with

a read and write device to allow the reading and writing of data in the respective

memory, characterized in that the initialization means are arranged to activate the read

device of the memory and the write device of the auxiliary memory under the control of

the initialization signal in order to read the data of the memory and to write in the

auxiliary memory at least these data of the memory which are not yet recorded in the

auxiliary memory **(A subscriber identity module (SIM) is contained within a cell**

phone that has a battery, memory and charger, where an initialization,

registration or modification process may take place that involves a database. For

example, the SIM reads information from an IP-Based Activation System (IBAS)

and then writes/stores this information into its memory during activation by a

user, and the database reads identification information from a SIM and then

writes/stores this information into its memory during a feature change by the

user. IBAS may identify the SIM during an initialization of data, Column 6, lines

62-67, Column 7, lines 1-5 and 61-64, Column 8, lines 1-5, 22-24 and 38-41 and

Column 9, lines 20-23). Amin does not teach the auxiliary memory is associated with

the charger, the said charger is provided with an initialization means connected to the

said read and write devices, and the said initialization means is arranged to detect a

charging of the power source and produce an initialization signal after detection of such

a charging. Mashiko teaches a secondary storage portion is located inside the charger,

where the storage portion of the charger works with a microcontroller, also inside the

charger, and stores information associated with an information management process

that evaluates both identification and password information and reads/writes information

to storage inside the portable phone and the secondary storage inside the charger

(Paragraph 19, lines 27-40 and Paragraph 53). Mashiko also teaches a control

portion for the battery charger that produces a charging signal for charging the battery

and subsequently allows for the information management process to take place

(Paragraph 19, lines 15-27 and Paragraph 23, lines 1-10). It would have been

obvious to one of ordinary skill in the art at the time of the invention to modify the

invention of Amin to associate the memory with the charger, an initialization means and

a power detection for the benefit of reducing costs and consuming power.

Regarding claim 2, Amin teaches an assembly comprising a mobile telephone, a

computer provided with a first memory and a communication module arranged to

establish a communication of data between the telephone and the computer, the said

telephone being provided with a second memory arranged to store therein data of the

operator and data introduced by an owner of the telephone, the said first and second

memories in each case being equipped with a read and write device for allowing the

reading and writing of data in the respective memory, the communication module being

provided with initialization means connected to the said read and write devices, the

said initialization means being arranged to detect an activation of the communication

module and to produce an initialization signal after detection of such an activation,

characterized in that the initialization means are arranged to activate the read device of

the second memory and the write device of the first memory under the control of the

initialization signal in order to read the data of the second memory and write in the first

memory at least those data of the second memory which are not yet recorded in the

first memory **(The above referred to assembly may function with a computer,**

Column 6, lines 44-48 and Column 14, lines 5-18).

Regarding claim 3, Amin teaches an assembly according to claim 1,

characterized in that an identification code is stored in the memories and in that the

initialization means comprise a verification element arranged to compare, under the

control of the initialization signal, the codes stored in the memory and the auxiliary

memory or respectively the first and second memory in order to produce a

neutralization signal in the event of a non-match of the identification codes compared

with each other, the said activation of the read and write device being neutralized

under the control of the neutralization signal **(An initialization takes place for**

establishing communication with the network, where a check is made on data

stored in both the SIM memory and the database, which includes identification

data called international mobile subscriber identity (IMSI). In case these 2 do not

match, the verification process is not successful and no reading/writing of data

may occur, for example, in the case of a feature change requested by a non-

verified user, Column 3, lines 9-13, Column 7, lines 61-67, Column 8, lines 1-5,

Column 9, lines 27-30, Column 16, lines 47-49 and Column 17, lines 7-11) .

Regarding claim 4, Amin teaches an assembly according to claim 1,

characterized in that the initialization means are arranged so as to activate the read

device of the auxiliary memory or respectively of the first memory under the control of

the initialization signal in order to read the data of these memories, the said

initialization means comprising a comparator arranged so as to receive data read in the

respective memories, after activation of the read devices, and to compare with each

other the data stored in the first and second memories or respectively the memory and

the auxiliary memory and to mark on the basis of the comparison the data of the

second memory or respectively of the memory which are not stored in the first memory

or respectively the auxiliary memory and to store in the first memory or respectively the

auxiliary memory only the data marked **(During a feature change, the user's data is**

1st verified by comparing database information with SIM memory information, as

described in claim 3 above. If the user is verified successfully, the user selects

what features they want and corresponding data is loaded into the database

accordingly, Column 7, lines 61-67, Column 8, lines 1-5, Column 16, lines 47-49

and Column 17, lines 7-11).

Regarding claim 5, Amin teaches an assembly according to claim 1,

characterized in that the initialization means are arranged to delete the content of the

auxiliary memory or respectively the first memory under the control of the initialization

signal **(Data may be overwritten in the SIM during roaming, Column 9, lines 50-53 and 59-61)**.

Regarding claim 7, Amin teaches an assembly according to claim 1, characterized in that the initialization means are provided with a transmitter arranged to transmit a message indicating a writing in the auxiliary memory or respectively the first memory when data are written in these **(Column 9, lines 17-23 and Column 11, lines 7-9)**.

Regarding claim 8, Amin teaches an assembly according to claim 1, characterized in that the initialization means comprise an activation key which can be activated by a user, the said activation key being arranged to produce an activation signal after having been activated, the said write devices of the memory or of the second memory and the said read devices of the auxiliary memory or the first memory being able to be activated under the control of the activation signal in order to allow writing in the memory or the second memory of the data read in the auxiliary memory or the first memory **(The user activates their services, and this is acknowledged through the releasing of an IP address, Column 14, lines 28-31 and step 688 in Figure 6C)**.

Regarding claim 9, Amin teaches an assembly according to claim 1, characterized in that the initialization means comprise a connection pin connected to a

conductive wire itself connected to the auxiliary memory, the said pin being compatible

with that of the telephone giving access to the memory **(A security key is featured**

that gives the SIM access to the network, which includes the database, Column

9, lines 43-50).

10. Initialization means to be used in an assembly according to claim 1 **(See claim 1)**.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
obviousness or nonobviousness.

13.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

14.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amin, in

view of Hicks **(US Patent No. 6,493,552)**.

        Regarding claim 6, Amin teaches the assembly according to claim 1. Amin fails

to teach the initialization means are provided with a counter having an input for

receiving the initialization signal, the said counter being arranged to increment a

counting amount after reception of the initialization signal and to produce a counting

signal when the counting level has reached a predetermined threshold and a stop signal

when this counting level has not reached the said threshold, the said initialization

means being arranged to neutralize the said activation of the read and write devices

under the control of the stop signal and to initialize the counting level under the control

of the counting signal. Hicks teaches the initialization means are provided with a

counter having an input for receiving the initialization signal, the said counter being

arranged to increment a counting amount after reception of the initialization signal and

to produce a counting signal when the counting level has reached a predetermined

threshold and a stop signal when this counting level has not reached the said threshold,

the said initialization means being arranged to neutralize the said activation of the read

and write devices under the control of the stop signal and to initialize the counting level

under the control of the counting signal **(A mobile subscriber attempting register**

attempts to register their mobile phone with the network a specific predetermined

number of times. If the predetermined number of times is reached, a new channel

is found, and if the number is not reached by the counter, the registration

attempts continue. The counter is incremented before the determination is made

on both occasions, and registration leads to reading and writing of identification

and other data in memory of the Home Location Register, Column 1, lines 31-43,

Column 2, lines 26-28 and 46-47, Column 5, lines 45-56 and Figure 3) It would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the

invention of Amin to include a counter for the benefit of added efficiency.

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

        US Patent No. 6,278,885 refers to a mobile phone using subscriber identification

        card for updating information stored therein.

        US PG Publication 2004/0204021 refers to a cell phone feature.

16.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached on Monday-Thursday, 8 am-5 pm and at the same time on alternate Fridays, EST.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

        Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

/Frank Donado/
Art Unit 2617

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617